

Appln No. 09/721,858  
Amdt. Dated April 26, 2005  
Response to Office Action of March 09, 2005

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### REMARKS/ARGUMENTS

The Office Action has been carefully considered. The issues raised are traversed and addressed below with reference to the relevant headings and paragraph numbers appearing under the Detailed Action of the Office Action.

#### *Final Office Action*

In the Conclusion section of the Second Office Action, the Examiner has indicated that this office action is made final. However, we respectfully submit that this was inappropriate.

In particular we refer to MPEP 706.07 Final Rejections [R-2] where it states:

*"...present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."*

Furthermore, it is also stated in this section of the MPEP that:

*"To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection."*

In response to the First Office Action, the Applicant amended claims 1 and 18 to include the features of previous claims 12 and 22 respectively. Although claims 12 and 22 were rejected by the Examiner, the cited documents (Hube et al and Delfer et al) made no reference to invisible machine readable codes, as was indicated in the response to the First Office Action.

Furthermore, the Examiner has in the Second Office Action cited a new document (Perkins et al) in order to reject the amended claim. Thus, although the Examiner is silent regarding whether Hube et al or Delfer et al showed the features of claims 12 or 22, it would appear that by citing a new document the initial rejection was unfounded.

The Applicant amended the claims in regard to the cited documents with a clear "view to avoid all the grounds of rejection and objection" in the First Office Action. This amendment did not raise any new issues for consideration, as this distinction was already present in the originally filed claims. Therefore, we believe the Second Office Action should not be made final.

In view of this we respectfully submit that the Examiner should not have made the Second Office Action final and accordingly the current response to the Second Office Action is being considered as made to a non-Final Office Action.

#### *Claim Rejections – 35USC § 103*

In this section, the Examiner has rejected claims 1 to 11, 13 to 21 and 23 to 25 as being unpatentable over Hube et al. in view of Perkins et al. (US. patent 5,655,759). However, the

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applicant disagrees with the Examiner but in order to more clearly distinguish the claimed printer from Hube et al. and Perkins et al., claims 1 and 18 have been amended to specify that the printer pages include machine-readable codes that are substantially invisible to the unaided human eye. This is supported at page line 5 of page 11 where it states "*[t]he printer is ideally enabled for printing codes which it can subsequently sense*".

Hube et al. fails to disclose machine-readable codes that are invisible to the human eye. Furthermore, Hube et al. fails to disclose a printer including the ability to print machine-readable codes that are invisible to the human eye.

Perkins et al. fails to disclose a printer that is able to print machine-readable codes. Furthermore, Perkins et al. fails to disclose a printer that is able to print machine-readable codes that are invisible to the human eye.

The printer as claimed in amended claims 1 and 18 provides numerous advantages over Hube et al. and Perkins et al. For example, if a page is printed with visible information and an invisible machine-readable code, the output printed page may subsequently be scanned at a later time so as to retrieve the electronic copy, and print a non-deteriorating copy of the page, as the page does not need to be re-scanned.

This advantage cannot be achieved by Hube et al because if the job reference sheets are not available, the page must be re-scanned. Therefore, a second copy is produced by re-scanning the first copy, reducing the quality of the second copy produced. Furthermore, the job reference sheets must be stored somewhere once the printed documents have been produced in order to reproduce another copy at some other time. However, with the claimed printer, only a copy of the output page is needed in order to scan the invisible machine-readable code so as to print another non-deteriorating copy of the page. Similar disadvantages would apply to Perkins et al.

Whilst the outstanding Office Action is a Final Office Action and we appreciate that the Examiner is not bound to consider new issues, we do draw the Examiner's attention to the fact that this action should not have been made final, as initially outlined above.

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### CONCLUSION

In light of the above, it is respectfully submitted that the objections and claim rejections have been successfully traversed and addressed. The amendments do not involve adding any information that was not already disclosed in the specification, and therefore no new matter is added. Accordingly, it is respectfully submitted that the claims 1 to 25, and the application as a whole with these claims, are allowable, and a favourable reconsideration is therefore earnestly solicited.

Very respectfully,

Applicant:



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PAUL LAPSTUN



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